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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,344	08/05/2003	Ronald P. Laliberty	043596.091	6750
25461	7590	08/04/2005		
SMITH, GAMBRELL & RUSSELL, LLP 1230 PEACHTREE STREET, N.E. SUITE 3100, PROMENADE II ATLANTA, GA 30309-3592			EXAMINER WONG, STEVEN B	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,344

Applicant(s)

LALIBERTY ET AL.

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 6, 11 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Yang (5,704,858). Regarding claims 1 and 6, note the basis for the rejections set forth in the Office Action mailed January 18, 2005. Regarding the added limitation for the core to comprise no more than two mantle layers, it would have been obvious to one of ordinary skill in the art to eliminate one of the layers (12) of Yang in order to produce a harder ball. Note column 2, lines 16-19 stating that the first layer (12) acts as a cushioning layer for absorbing vibrations and shocks. It would have been obvious to one of ordinary skill in the art to eliminate the layer (12) as such would constitute a mere elimination of a part and its associated function. *In re Karlson*, 136 USPQ 184; *In re Wilson et al.*, 153 USPQ 740.

Regarding claims 11 and 22, note the basis for the rejection set forth in the Office Action mailed January 18, 2005 stating that the recited dimensions are considered to be obvious lacking a showing for its criticality.

3. Claims 2, 4, 5, 7-10 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang (5,704,858) in view of Talarico et al. (5,951,420). Note the basis for the rejections set forth in the Office Action mailed January 18, 2005.

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4. Claims 3, 12, 13 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang (5,704,858) in view of Talarico et al. (5,951,420) and Walker et al. (5,647,590). Note the basis for the rejections set forth in the Office Action mailed January 18, 2005.

Response to Arguments

5. Applicant's arguments filed March 18, 2005 have been fully considered but are not deemed to be persuasive. Regarding the applicant's argument that amended claim 1 defines "no more than two mantle layers", attention is directed to the basis for the rejection stated above where it is considered to have been obvious to one of ordinary skill in the art to eliminate one of the layers (12) in order to produce a harder ball. The elimination of the layer in the ball of Yang is seen as a mere elimination of a part and its associated function. *In re Karlson*, 136 USPQ 184; *In re Wilson et al.*, 153 USPQ 740. Yang discloses that the layer (12) acts as a cushioning layer for absorbing vibrations and shocks. It would have been obvious to one of ordinary skill in the art to eliminate this layer in the ball of Yang in order to produce a harder ball. Regarding the applicant's argument that the ball of Yang is soft whereas the ball of the instant invention is hard, this limitation is not recited in the claims. Further, the argument that Yang's ball is a safety ball whereas the ball of the instant invention is for a competitive or regulation ball relates to the intended use of the ball and again this limitation is not recited in the claims.

Regarding the combination of Yang in view of Talarico et al., the applicant argues that Talarico teaches an opposite arrangement of layers in comparison to Yang. The applicant states that Talarico provides a softer core and layers of increased hardness whereas Yang provides a hard core with softer mantle layers. However, this argument is not persuasive as Talarico et al. is not relied upon for his specific arrangement of layers for the ball. As stated in the Office Action

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mailed January 18, 2005, the reference to Talarico et al. is relied upon merely for its teaching that it is well known in the art of game balls to use polyurethane material to form the layers in order to take advantage of that material's well known physical characteristics.

Regarding the applicant's argument that the urethane composition of the instant invention provides particular aspects, these limitations are considered to be obvious given the teachings of Talarico et al. that urethane is well known in the art of game balls and the lack of a showing of the criticality of these particular aspects by a new and unexpected result obtained therefrom.

Regarding the reference to Walker, this reference is cited merely as a teaching that it is well known in the art of game balls to form polyurethane foam from a mixture of 100 parts polyol and 33-40 parts isocyanate. The reference to Yang provides the teachings for the particular layers and their associated hardnesses.

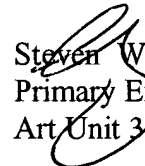
Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Wednesday 7am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven Wong
Primary Examiner
Art Unit 3711

SBW
August 1, 2005